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JEP
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GROUP 120

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

is patent application of : Group Art Unit: 125
TERRELL, Ross C. :
Serial No. 07/010,106 : Examiner: J. Goldberg
Filed: February 2, 1987 : Atty. Dkt.: PP4351
For: ANESTHETIC COMPOSITION AND :
METHOD OF USING THE SAME : Date: October 2, 1987

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

RESPONSE TO REJECTION

Sir:

Applicant wishes to thank the Examiner for the courtesy extended during the interview of June 4, 1987. The matters discussed are set forth below.

Claims 1-7 are presently pending. Claim 7 has been withdrawn from consideration as drawn to a non-elected invention. Applicant hereby affirms this election.

Claims 1-6 have been rejected under 35 USC 102(a) as anticipated by or, in the alternative, under 35 USC 103 as obvious over the Russell et al. patent. The Examiner stated that it is clear from column 9, lines 15-30 that all of the compounds were tested for inducing anesthesia.

This rejection is respectfully but emphatically traversed.

Russell et al. is directed to a method for partially fluorinating an alkane or a cycloalkane polyfluoroether feedstock employing molecular fluorine. As such, the claimed feedstock can cover a large multitude of compounds. In claim 4 of the Russell et al. patent, the polyfluoroether feedstock is defined as a compound having the structure of $\text{CHF}_2\text{CF}_2(\text{CF}_2$

$\text{CF}_2)_n\text{CH}_2\text{OR}$, in which R is a lower alkyl and n is 0 to 4. Clearly the claims of the Russell et al patent cover a host of compounds that can be fluorinated and not a restricted class of compounds with certain properties. As stated in the specification of the patent, the "polyfluoro-containing ethers made in accordance with the method of this invention... have useful solvent properties... can be used to prepare pastes and dispersions of... olefins and waxes to provide coatings, and polyfluoro ether products can be used as degreasing agents". The patent also states that "Some of the polyfluoro-containing products which can be made by the method of this invention are also useful as agents for producing anesthesia in anesthesia-susceptible, airbreathing animals". [emphasis added] Column 1, lines 23-26 and Column 9, lines 9-11. The patent discloses as examples of the claimed method of synthesis, the preparation of 25 compounds, number 22 of which is the compound used in the present invention. The patent states that "In order to determine the potency of these fluorinated ethers as inhalation anesthetics in combination with oxygen, tests were carried out on mice... The products of Examples XIII, XIV, XVI and XII and the ... product of Example XVII were found to have anesthetic activity".

There is absolutely no teaching in the Russell et al. patent that would lead one of ordinary skill in the art to the presently claimed method of use and anesthetic composition. In this regard, it is noted that there is no disclosure that the compound in question has anesthetic properties. The Examiner bases his rejection on his inference that compound 22 was tested for inducing anesthesia. Whether or not the compound was tested is irrelevant. The mere fact that a compound was tested does not infer whether or not it is an anesthetic.

Screening is performed to find out if a compound has a desired property. The mere act of screening does not establish whether a compound has the property sought by screening. "Obvious to try" is not the proper test of patentability.

In view of Applicant's duty of candor, Applicant wishes to make clear that no representation is made or intended as to whether or not compound 22 actually was a part of the testing mentioned in Russell et al., even though it is within Applicant's knowledge (Russell et al. has the same assignee). Applicant does not wish to muddy the relevant issue under 35 U.S.C. 103 according to Graham vs. John Deer, 148 USPQ 459 (S.C. 1966): What is the scope and content of the prior art? Information not within the disclosure of the Russell et al. patent is trade secret information, not prior art under 35 USC 102 or 103.

Claims 1-6 have been rejected under 35 USC 103 as being unpatentable over Terrell et al. '425, Terrell et al. '705 and Bagnall. The Examiner states that Terrell et al '425 teaches the 1-chloro derivative for inducing anesthesia, Terrell et al. '705 teaches the 1-bromo derivative for inducing anesthesia, and Bagnall teaches a similar compound where the 1-fluoro can be substituted for inducing anesthesia. The Examiner therefore concludes that Applicant's 1-fluoro derivative for inducing anesthesia would be prima facie obvious in the absence of a showing.

The 1-chloro derivative disclosed in the Terrell et al '425 patent is isoflurane, the most widely used inhalation anesthetic in North America. The compound recited in the present claims is being developed by the assignee company as an improvement over isoflurane in an important respect, namely, the recovery time of a patient following use of the compound.

As the trend in hospital care has been toward shorter hospital stays and outpatient surgery, there has concomittantly been a search for an inhalation anesthetic composition which would allow a patient to recover faster and which would in some cases even allow a patient to be "street ready" shortly following surgery. An affidavit (preliminary copy attached) by a consultant and eminent Anesthesiologist, Dr. E.I. Eger, II, will attest to the comparatively rapid recovery associated with the present anesthetic composition and method of use. The evidence in this affidavit is believed to constitute a highly significant showing of unobviousness as requested by the Examiner.

Additionally, Applicant would like to call the Examiner's attention to the attached Citation of Prior Art.

In view of the above, it is believed that the invention is patentable and the application in condition for allowance. Such action is earnestly solicited.

Respectfully submitted,

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